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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/479,648	01/07/2000	RONALD S. STEELMAN	54655USA1B	3344

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04/09/2002

OFFICE OF INTELLECTUAL PROPERTY COUNSEL  
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EXAMINER

GALLAGHER, JOHN J

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 04/09/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

MF=10

# Office Action Summary

Application No. 09/479648	Applicant(s)	
Examiner	Group Art Unit	

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 08 JANUARY 2002
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 20-31 and 34-66 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 29-31, 34-40 and 64 is/are allowed.
- ☒ Claim(s) 20-28, 41-43, 45-63 and 65-66 is/are rejected.
- ☒ Claim(s) 44 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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1. Paragraph 2 of the last Office action is hereby reiterated; this claim and the disclosure should be brought into correspondence.

2. Claim 44 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations of this claim have apparently already been incorporated into claim 34.

3. Claim 43 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Specifically, this claim is seen to be inconsistent with claim 34 (i.e. pressure sensitive vs. heat activated adhesive).

4. Claims 41-42, 45-56 and 62-63 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, applicants' specification apparently clearly indicates (N.B. page 3 lines 26-31 and page 4 lines 11-22) that the envisioned method is

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intended for use on a truck trailer SIDE and NOT on an unspecified wall i.e. it is clearly stated (N.B. page 4 lines 17-19) that the vehicle environment disclosed constitutes a "vastly different" environment and prior art area than the generalized wall application now claimed. This could be considered to be a new matter rejection; further along this line, however, N.B. paragraph 25 of Corometrics v. Berkeley 193 USPQ 467.

5. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 20 and 22-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gladen (already of record - see paragraph 5 of the last Office action). The modification of the apparatus of this patentee to allow for the independent operation of the heat and pressure application means ~~fail~~ <sup>IS ~~NOT~~ SEEN</sup> to constitute an obvious expedient to those of ordinary skill in this art, in that it has long been appreciated and accepted that in general concurrently performed steps are equivalent to those performed

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successively (In re White 5 USPQ 267), especially when the steps are PHYSICAL in nature (as in the instant situation viz. heating and pressing). Further along this line, the Teflon pad of this patentee is held to indeed constitute a HNPF i.e. it is seen to satisfy the criteria (i.e. possess the properties and characteristics) set forth in applicants' specification at page 5 line 22 thru page 6 line 7.

7. Claims 57-61, 65-66, 21 and 24-28 are rejected, and claims 20 and 22-23 are further rejected under 35 U.S.C. § 103(a) as being unpatentable over Hargarter et al. in view of Gladen. This rejection is adhered to essentially for the reasons of record (see paragraph 10 of the last Office action); further along this line (a) N.B. column 6 line 66 thru column 7 line 1 and column 12 lines 24-2 of Hargarter et al.; and (b) with respect to claim 28 (i.e. the "wherein" clause), note that expressions relating an apparatus to the contents thereof during operation are of no significance in determining the patentability of an apparatus claim (Ex parte Thibault 164 USPQ 666; In re Rishoi 94 USPQ 71; Ex parte Cullen 132 USPQ 148).

8. Applicants' arguments filed 08 January 2002 have been fully considered but they are not deemed to be persuasive. See paragraphs 2-7, above.

9. In spite of the foregoing rejections, the Examiner feels that there is patentable subject matter present in this

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application at this point in prosecution, and therefore claims 29-31, 34-40 and 64 are indicated as being allowable, with the caveat that yet another updated search may uncover art more pertinent than that already of record.

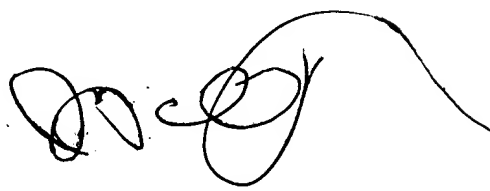
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. J. Gallagher whose telephone number is (703) 308-1971. The examiner can normally be reached on M-F from approximately 8:30 A.M. to 5 P.M. The examiner can also be reached on alternate N/A.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for this Group is (703) <sup>872-9310</sup> ~~305-3599~~.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661/0662.

JJG  
JJGallagher:cdc

March 25, 2002

  
JOHN J. GALLAGHER  
PRIMARY EXAMINER  
ART UNIT 131 1733